

REMARKS

Claims 1-6, 8-14, 16, and 17 are currently pending in the above-identified patent application. In the above-identified Office Action, the Examiner rejected claims 1, 3, 5, 8, 10, 11, 13, and 16 under 35 U.S.C. 103(a) as being unpatentable over Nolen (U.S. Patent No. 590,330) in view of Borah (U.S. Patent No. 2,421,238), since the Examiner asserted that Nolen teaches a scissors comprising a first shaft, a second shaft, a pin (a3), an adjustable thumb ringlet (a2) and a second pin (r) in Figs. 1-3 and 6. However, the Examiner continued that Nolen does not teach the pin (a3) being flexible, but Borah teaches the use of a flexible pin 24 to connect separate parts together in Fig. 3.

The Examiner then concluded that it would have been obvious to one skilled to replace Nolen's pin with Borah's flexible pin for easily securing the thumb ringlet to the handle portion.

Applicant respectfully disagrees with the Examiner concerning the rejection of claims 1, 3, 5, 8, 10, 11, 13, and 16 under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah, for the reasons to be set forth hereinbelow.

Regarding claims 2 and 12, the Examiner continued that the modified scissors of Nolen teaches the invention substantially as claimed except for the material of the pin (a3), and that to select a well-known material such as thermoplastic polymers for Borah's pin would have been obvious to one having ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Applicant respectfully disagrees with the Examiner concerning this ground of rejection for the reasons to be set forth hereinbelow.

The Examiner rejected claims 1, 3-6, 8, 10, 11, 13, 14, and 16 under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah as applied to claim 1 above, and further in view of Earnest et al. (U.S. Patent No. 3,374,541), hereinafter Earnest, since the Examiner again stated that regarding claims 1, 5, 8, 10, 11, 13, and 16, Nolen teaches a scissors comprising a first shaft, a second

shaft, a pin (a3), an adjustable thumb ringlet (a2) and a second pin (r) in Figs. 1-3 and 6, but that Nolen does not teach the pin (a3) being flexible. However, the Examiner again stated that Borah teaches the use of a flexible pin 24 to connect separate parts together in Fig. 3, and that it would have been obvious to one skilled to replace Nolen's pin with Borah's flexible pin for easily securing the thumb ringlet to the handle portion.

Applicant again respectfully disagrees with the Examiner's repetition of the rejection of claims 1, 3-5, 8, 10, 11, 13, and 16 under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah.

Regarding claims 3 and 4, the Examiner continued that Nolen teaches the invention substantially as claimed except for the thumb ringlet in Fig. 1 having an opening facing upward, but that Earnest teaches providing an opening 13 facing upward in a thumb ringlet to comfortably fit fingers of varying girth in Figs. 1-3. The Examiner then concluded that it would have been obvious to one skilled in the art to provide the thumb ringlet of Nolen an opening facing upward as taught by Earnest to comfortably fit fingers of varying girth.

Applicant respectfully disagrees with the Examiner concerning the rejection of claims 3 and 4 for the reasons to be set forth hereinbelow.

Claims 6 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah as applied to claim 1 above, and further in view of Mock (U.S. Patent No. 6,131,291), since the Examiner stated that the modified scissors of Nolen teaches the invention substantially as claimed except for a means for adjusting the force between opposing cutting portions (A,B) of the scissors, and that Mock shows a pair of shears comprising means (20,50) for adjusting the force of the shear blades in Col. 3, line 66 to Col. 4, line 1. The Examiner concluded that it would have been obvious to one skilled in the art to further modify Nolen's scissors by providing the scissors with a force adjusting means to facilitate adjusting the ride of the blades as taught by Mock.

Applicant respectfully disagrees with the Examiner's rejection of Claims 6 and 14 under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah

as applied to claim 1 above, and further in view of Mock for the reasons to be set forth hereinbelow.

Claims 9 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah as applied to claim 1 above, and further in view of Brenton et al. (U.S. Patent No. 5,469,624), hereinafter, Brenton, since the Examiner stated that the modified scissors of Nolen teaches the invention substantially as claimed except for a finger stabilizer, but that Brenton shows a pair of scissors comprising a finger stabilizer disposed in the vicinity of a finger ringlet 26 in Fig. 1a. The Examiner concluded that it would have been obvious to one skilled in the art to modify Nolen's scissors by providing the finger ringlet (B3) with a finger stabilizer for supporting a user's finger when in use as taught by Brenton.

Applicant respectfully disagrees with the rejection of claims 9 and 17 under 35 U.S.C. 103(a) as being unpatentable over Nolen in view of Borah as applied to claim 1 above, and further in view of Brenton, for the reasons to be set forth hereinbelow.

Turning now to Nolen, applicant wishes to point out that Nolen teaches in Col. 2, lines 57-66, that: "Upon the handle A², adjacent to its rear end, is mounted a thumb-holder or ring, a², preferably of sheet metal, pivoted thereto by means of a double-headed pin or rivet a³, headed loosely enough to permit said ring to be rotated on the surface of the handle in any direction desired and be retained generally at right angle or across the handle when the blades are pushed away from the operator." (Emphasis added by applicant.). Additionally, in Col. 3, lines 4-9, it is stated that: "Although the thumb-handle A² is preferably provided with the ring a² as a thumb-retainer, the thumb-retainer may be in the form of a loop, as shown at a⁴ in Fig. 6, that is pivotally retained by means of the double-headed pin a³." (Emphasis added by applicant.). Clearly, Nolen teaches away from a flexible pin or rivet in that thumb-holder a² is required to be retained generally at a right angle across thumb-handle A².

Borah teaches in Col. 3, lines 10-50 that: "Where expansible securing members are employed, they may assume the characteristics illustrated in Figs. 3-7. The securing member **24**, illustrated in Figs. 3-5, comprises a cylindrical shank

25 having a large head **26** at one end and a smaller rounded head **27** at the other end. Head **27** and shank **25** are provided with two or more substantially equi-angularly disposed longitudinal slots or kerfs **28** which terminate short of head **26**, and divide the shank and head **27** into a plurality of similar longitudinal parts which are spaced apart a distance slightly greater than the width of shoulders **29** formed between the head portion **27** and shank **25** of each longitudinal or divided fastener part. The securing members **24** are preferably formed of wood or plastic material which has at least a slight degree of resilience, whereby said longitudinal parts may be flexed radially inwardly with their radial faces in engagement at their outer ends adjacent head portions **27**. The diameter of shank portion **25** is preferably slightly less than that of the openings in the paper board box parts and in member **22**, and the normal or expanded diameter of head **27** is preferably slightly greater than that of said openings by an amount just sufficient to permit solid anchorage of shoulders **29** with the face of member **22** around its opening. To facilitate insertion of a wooden member **24** through such an opening in member **22**, the width of each kerf **28** at head portion **27** is preferably slightly greater than at the remainder of said kerf, as illustrated in Fig. 3. The spacing of the inner faces of the opposed heads **26** and **27** is equal to or slightly less than the thickness of the parts through which the securing member passes whereby said securing members hold the parts connected thereby firmly in face engagement. Where the spacing is less, the paper board parts are slightly compressed in the operation of applying the securing member." (Emphasis added by applicant.).

Borah continues in Col. 3, lines 51-68, for metal fasteners that: "The construction of fastener illustrated in Figs. 6 and 7 is substantially the same as that above described, except that it is hollow as when made from sheet metal. Thus a shank **30** is formed from tubular material slotted longitudinally in equi-angular relation at **31** for the major portion of its length to define transversely arcuate spaced longitudinal shank portions. An outwardly flaring flange **32** is formed at the unslotted end of the shank. A cup-shaped head comprising a circular plate **33** having its margin **34** spun or otherwise bent around flange **32** is mounted on the rigid end of the shank. The shank portions are configured at their slotted ends to

provide a substantially perpendicular outwardly directed shoulder **35**, and they terminate in inwardly bent end portions **36** tapered from shoulders **35**.” (Emphasis added by applicant.).

Subject claim 1 recites: “...a flexible pin adapted to be inserted through the hole in said thumb ringlet and into the tubular portion of said first shaft for rotatably connecting said thumb ringlet to said first shaft; ...,” while subject claim 10 recites: “means for rotatably connecting said thumb ringlet to said first shaft;” The means-plus-function recitation of claim 10 is clearly defined in the subject Specification, as originally filed (See, e.g. page 3, lines 1-3 of the subject Specification).

The word “pin” is defined as “1. A cylindrical fastener made of wood, metal, or other material used to join two members or parts with freedom of angular movement at the joint. 2. A short, pointed wire with a head used for fastening fabrics, paper, or similar materials.” (See, e.g., McGraw-Hill Dictionary of Scientific and Technical Terms, Fifth Edition, Sybil P. Parker, Editor in Chief, McGraw-Hill, Inc. (1994).). Additionally, “thermoplastic” is defined in The American Heritage Dictionary of the English Language, Third Edition, as “adj. Becoming soft when heated and hard when cooled.”

Applicant wishes to point out that Borah neither defines a “pin” as used in Nolen, **nor uses the term “thermoplastic.”** In fact, **Borah only uses the terms “securing members” and “expansible fastener”** when referring to member **24** thereof. In what follows, applicant assumes that the Examiner meant that the materials used in Borah are metal, wood or plastic as recited therein, and not “thermoplastic.”

From the underlined portions of Borah set forth hereinabove, Borah clearly teaches that: (1) Head **27** and shank **25** are provided with two or more substantially equi-angularly disposed longitudinal slots or kerfs **28** which terminate short of head **26**, and divide the shank and head **27** into a plurality of similar longitudinal parts; (2) The securing members **24** are preferably formed of wood or plastic material which has at least a **slight degree of resilience**, whereby said longitudinal parts **may be flexed radially inwardly** with their radial faces in engagement at their outer

ends adjacent head portions **27**; (3) The normal or expanded diameter of head **27** is preferably slightly greater than that of said openings; (4) Where the spacing is less, **the paper board parts are slightly compressed in the operation of applying the securing member**; and (5) The construction of the fastener illustrated in Figs. 6 and 7 is substantially the same as that above described, **except that it is hollow** as when made from sheet metal.

Thus, the fastener of Borah teaches away from the pin of Nolen in several ways: (1) The flex attributed to the fastener of Borah by the Examiner as being longitudinal, is not longitudinal, but radial; (2) Borah specifies only a slight degree of resilience; (3) The fastener of Borah has a head larger than the paper into which it is inserted, requiring that the paper is slightly compressed upon insertion, while clearly, a wooden or plastic fastener could not deform the sheet metal parts of Nolen; and (4) Borah teaches a hollow fastener if metal is used instead of wood or plastic, whereas the pin of Nolen must be a solid, metallic pin in order that a head can be formed once it is inserted through thumb-holder, a2, and into thumb-handle, A2.

A. It is Improper To Combine References Which Teach Away From Their Combination.

Section 2145 of the Manual of Patent Examining Procedure states that: "It is improper to combine references where the references teach away from their combination." Further, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus of Nolen to accept the fastener of Borah is incorrect, since the resulting combination would not produce a functioning device for Nolen. In fact, the fastener of Borah would not even fit into the holes in either the thumb-holder, a2, or the thumb-handle, A2, provided therefor.

Therefore, the Examiner has failed to make a proper *prima facie* case for obviousness as is required under 35 U.S.C. 103(a) by combining Borah with Nolen.

B. The Examiner Has Not Properly Used The Motivation-Suggestion-Teaching Requirement.

Applicant respectfully believes that the Examiner has improperly combined Borah with Nolen, since there would be no motivation to make this combination. As examples, Borah specifically rejects the requirement of a solid metal pin or rivet of Nolen, and the fastener of Borah cannot be inserted into the holes in thumb-holder, a2, or the thumb-handle, A2, of Nolen provided therefor. The “motivation-suggestion-teaching” requirement protects against the entry of hindsight into the obviousness analysis, a problem Section 103 was meant to confront. *In re Kahn* (Fed. Cir. No. 04-1616, March 22, 2006). The Examiner has thus failed to make a proper *prima facie* case for obviousness by suggesting that Borah should be combined with Nolen.

C. The Examiner Has Used Hindsight In The Combination Of Borah With Nolen.

There is no teaching in Borah that the fastener thereof supports relative rotation of the parts connected thereby. In fact, the longitudinal parts of the fastener of Borah would likely collapse if the pieces held thereby were to be rotated. By combining the teachings of Nolen and Borah, the Examiner has attempted to reconstruct applicant’s invention using hindsight. Section 2145 X. A. of the Manual Of Patent Examining Procedure states that: “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).” Applicant believes that the use of a flexible pin to rotatably attach a thumb ringlet to the shank of a scissors or a grasping instrument, in the manner taught by the present claimed invention and recited in subject claims 1 and 10 was unknown by others at the time the present invention was made, and that the Examiner has used knowledge “gleaned only” from applicant’s disclosure that such attachment would be successful. Therefore, applicant believes that there would be no motivation, suggestion or teaching to

combine the teachings of Nolen with those of Borah in order to render obvious the present claimed invention.

D. The Use Of Hindsight By The Examiner Is Impermissible.

The Federal Circuit ruled in *In re Kahn* (Fed. Cir. No. 04-1616, March 22, 2006), that a Board of Patent Appeals and Interferences must articulate the motivation, suggestion or teaching that would have led the skilled artisan at the time of the invention to combine prior art elements to make the claimed invention. To establish a *prima facie* case of obviousness based on a combination of prior art elements, “the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention, When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed invention as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.” The Examiner has merely stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus of Nolen to employ the fastener taught by Borah without providing any motivation to make such a change. Applicant therefore respectfully believes that this bare statement by the Examiner does not rise to a motivation, suggestion or teaching as required by the court in *In re Kahn*, especially since the use of this combination in the manner suggested by the Examiner has been rejected by Borah.

E. Obvious To Try Is Not The Proper Standard For Obviousness Under 35 U.S.C. 103.

Section 2145 X. B. of the Manual Of Patent Examining Procedure states that: “... ‘The admonition that ‘obvious to try’ is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been ‘obvious to try’ would have been to vary all parameters to try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. ... In others, what was ‘obvious to try’ was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general

guidance as to the particular form of the claimed invention or how to achieve it' *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).” There is no suggestion or evidence in Borah that a hollow or segmented fastener could be used in place of the solid metal pin of Nolen. Nor, is there a suggestion or evidence in Borah that the wood or plastic fasteners of Borah could be fit through the holes in thumb-holder, a2, or thumb handle, A2, provided therefor in Nolen. Therefore, the Examiner’s assertion that it would have been obvious to apply the invention of Borah for the purpose of rotatably attaching the members of Nolen is at best merely a statement that it would have been ‘obvious to try’ the fastener of Borah in the scissors of Nolen, which is not the proper standard under §103.

Further, MPEP Article 2143.01 Suggestion or Motivation To Modify the References, Section III. Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness, states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” Here, the rejection of a solid metal pin by Borah mitigates against the desirability of the combination.

Applicant, therefore, believes that the Examiner has improperly combined the teachings of Borah with those of Nolen, and has failed to make a *prima facie* case for obviousness under 35 U.S.C. 103(a).

Moreover, as stated hereinabove, since applicant believes that claims 1 and 10 are patentable over the combination of Nolen with Borah, claims dependent therefrom are likewise patentable because the Earnest, Mock and Brenton references fail to cure the difficulties stated hereinabove regarding the combination of Borah with Nolen, as suggested by the Examiner.

In view of the discussion presented hereinabove, applicants believe that subject claims 1-6, 8-14, 16, and 17, are in condition for allowance or appeal, the

former action by the Examiner at an early date being earnestly solicited.

Reexamination and reconsideration are respectfully requested.

Respectfully submitted,

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